

REMARKS

Applicant reviewed the final Office Action dated February 14, 2006, and greatly appreciates the wholesale withdrawal of the improper rejections of all claims based on the Swan et al., Carey, Jr. et al., EP 0538047A1, and Weinle et al. references maintained in the past several Office Actions. In light of the following remarks, Applicant respectfully requests reconsideration of the new obviousness rejections made, as well as the continued rejection of all claims as allegedly violating the written description requirement of Section 112, first paragraph.

Initially, Applicant respectfully submits that no basis exists for making the most recent Office Action final. Contrary to the supporting statement made in the Office Action, no amendment necessitated any new ground of rejection. Instead, Applicant attacked the Examiner's rejections as flawed. The Examiner agreed with the correctness of the Applicant's position by withdrawing the rejections (a concession that a case of *prima facie* anticipation or obviousness was indeed lacking), but now presents new rejections based on a previously uncited reference: U.S. Patent No. 6,165,921 to Nagata et al.

Nothing in the rules or MPEP condones making an Office Action final when a *prima facie* rejection is lacking, and then allegedly made for the first time in a subsequent Office Action when a new reference is cited in support of the rejection. Quite the contrary, the MPEP at Section 706.07 specifically cautions the examiner to "never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." Since Applicant has not had a "full and fair hearing" with respect to the newly cited support for the rejection made, the Examiner should withdraw the finality of the Office Action and give the Applicant an opportunity to respond to the new basis for the rejections and set a proper record for purposes of appealing the rejections.

Turning to the issues raised in the final Action, claims 15, 21, and 23 requiring "primary fibers free of melt-blown fibers" stand finally rejected under 35

USC §112, first paragraph as allegedly containing new matter. Instead of again attempting to advance an “expressed support” requirement, the Examiner now posits that the written description would not “reasonably lead” those skilled in the art to the claimed exclusion of melt-blown fibers “since the disclosure fails to define or describe what are suitable fibers for the invention[.]” Neither the standard applied by the Examiner in evaluating the Applicant’s written description nor the statement made in support of the rejection is correct.

As emphasized previously, the written description requirement of Section 112, first paragraph clearly does not require that the specification expressly “define or describe” the claimed invention. Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that the inventor had possession of the concept of what is claimed. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). As the Examiner ostensibly acknowledges by withdrawing the argument previously made, no requirement exists for expressed or literal support for a claim limitation in the specification.

Proper application of these well-established tenets to a situation involving a “negative limitation” not expressly mentioned in the specification is perhaps best understood by reviewing the controlling decision of *Ex parte Parks*, 30 USPQ2d 1234 (Bd. Pat. App. & Int. 1994). There, the Board held that, despite the fact that the application failed to mention the “in the absence of a catalyst” limitation recited in the claims:

. . . it cannot be said that the originally filed disclosure would not have conveyed to one having ordinary skill in the art the *concept* of effecting decomposition at an elevated temperature in the absence of a catalyst.

Noteworthy, the catalyst was not “defined or described” in the application in *Ex parte Parks*, yet the Board resoundingly rejected the notion that the limitation requiring its absence constituted “new matter.” Instead, the Board found that a

skilled artisan would understand that the lack of any mention of a catalyst means that the reaction was accomplished in the absence of one.

Likewise here, the fact that the specification does not expressly "define or describe" melt-blown fibers would mean to a skilled artisan (or to anyone, for that matter) that the disclosed primary fibers are not melt-blown (which is all the limitations at issue require). Stated another way, if the Applicant now claimed melt-blown fibers, the Examiner would rightly contend that such is not disclosed and cannot be claimed. It follows, therefore, that excluding a type of fibers not expressly disclosed cannot in any way constitute new matter, which is essentially the holding of *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification having described the whole, necessarily described the part remaining."). In rejecting the claims at issue as lacking an adequate written description, the Examiner not only fails to appreciate this point of fact, but also fails to follow or distinguish the controlling decision of *Ex parte Parks*.

Instead of distinguishing *In re Johnson*, the Examiner instead cites to the earlier decision of *In re Smith*, 458 F.2d 1389, 173 USPQ 679 (CCPA 1972). In doing so, the contention is made that *In re Smith* is somehow "contrary to Applicant's arguments." However, a close review of its holding reveals that this is not at all the case and, in fact, *In re Smith* actually supports the Applicant's position.

As noted by the Examiner, *In re Smith* stands for the proposition that "a subgenus is not necessarily described by a genus encompassing it and a species upon which it reads" (emphasis added). In making this statement, the Board expressly held that "[p]recisely how close the description must come to comply with § 112 must be left to case-by-case development." Applicant's arguments regarding the applicability of the facts of this case to the law are in no way "contrary" to this holding.

From a factual standpoint, *In re Smith* was also expressly distinguished in *In re Johnson* relied upon by the Applicant, with the court observing that:

In *Smith* the applicant sought the benefit of his prior application for a broadened generic claim, replacing the claim limitation "at least 12 carbon atoms . . ." with a new limitation calling specifically for 8 to 36 carbon atoms, where there was no disclosure of either the range itself or of a sufficient number of species to establish entitlement to the claimed range. Appellants, in contrast to the applicant in *Smith*, are narrowing their claims . . .

Unlike in *Smith*, but as in *Johnson*, Applicant here is trying to claim a fully supported genus while narrowing the claim to exclude a species of polymer fibers (namely, those that are melt-blown) rather than "attempting to present a broadened generic claim." Thus, the "case-by-case" approach suggested by *In re Smith* hardly supports the proposition that a claim cannot be narrowed to exclude an unnamed species without running afoul of the written description requirement. Indeed, *In re Johnson* specifically holds otherwise. Hence, the lone case cited by the Examiner as supporting these rejections is distinguishable, and no explanation is provided as to why the factually on point cases cited by the Applicant do not control here. Reconsideration of the rejections applying the correct legal analysis is therefore respectfully requested.

Claims 22 and 24 requiring primary fibers "other than polypropylene" also stand finally rejected as allegedly running afoul of the written description requirement. Just like in *Ex parte Parks*, the present specification conveys the concept of using various polymer fibers other than polypropylene as the claimed primary fibers. Specifically, the paragraph bridging pages 5 and 6 of the present specification reads as follows:

The primary fibers 16 can be any type of fibers suitable for providing good structural qualities as well as good acoustical and thermal properties. Preferred fibers for use as the primary fibers 16 are polymer fibers . . . A preferred type of primary fibers for use with the invention are made of polyethylene terephthalate (PET) fibers, preferably having a diameter within the range of from about 3 to about 30 microns. The primary fibers are preferably present in an amount that is within the range of from about 30 to about 95 percent by weight of the blanket of fibers, exclusive of the facing, and the

bicomponent binder fibers are preferably present in an amount within the range of from about 5 to about 70 percent by weight. Most preferably, the primary fibers are PET fibers that are present in an amount that is within the range of from about 40 to about 80 percent by weight of the whole insulation product, exclusive of facings, and the bicomponent binder fibers are present in an amount within the range of from about 20 to about 60 percent by weight.

Clearly, this paragraph identifies polyethylene terephthalate fibers as a preferred type of primary fiber, and proceeds to explain that the primary fibers are most preferably polyethylene terephthalate fibers in an amount that is within the range of from about 40 to about 80% by weight of the whole insulation product. Thus, the contention made in support of the rejection that the "disclosure fails to define or describe what are suitable fibers for the invention" is completely and utterly false.

The Examiner understandably agrees that polyethylene terephthalate fibers are not polypropylene. Hence, this description of using PET constitutes a full and complete disclosure of the concept of utilizing "polymer fibers other than polypropylene" for the present invention. In attempting to refute this contention, the Examiner argues that "the exclusion . . . of polypropylene fibers is not described with sufficient particularity," but identifies no legal support for such a requirement. Indeed, the Examiner even agrees that polymer fibers other than polypropylene are in fact described in Applicant's specification, consonant with the limitation at issue. Hence, the present invention as set forth in claims 22 and 24 undoubtedly has support in the original specification, and the rejections based on the alleged inclusion of "new matter" should be withdrawn.

Substantively, the Examiner for the first time in the final Office Action rejects claims 1-9, 15-18, and 21-24 as being obvious based on the combination to Nagata et al. and the previously cited patent to Swan et al. First of all, it is again noted that claim 1 stands *canceled*. Thus, it is simply not subject to rejection.

Secondly, the Action fails to state a *prima facie* case of obviousness, since absolutely no motivation is identified for combining the teachings of the newly cited Nagata et al. reference with those of Swan et al., or for arriving at Applicant's claimed inventions. "To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject manner as a whole to have been obvious in view of multiple references, the [Examiner] must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct." *In re Kahn*, Appeal No. 04-1616 (Fed. Cir. March 22, 2006). Furthermore, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*<sup>1</sup>

In the statement of the rejection supporting the combination of the Nagata et al. and Swan et al. references, the Examiner contends that:

Since both references are directed to acoustical material for use in automotive applications, the purpose disclosed by SWAN et al. would have been recognized in the pertinent art of NAGATA et al. It is noted that the references are analogous art and that the NAGATA et al. provide all the structural limitations of the claimed blanket of polymer fibers and that SWAN et al. provides motivation for the lamination of such blanket to second layer and for the provision of areas of reduced thickness (equated to the claimed flanges).

That Swan et al. "provides motivation" for "lamination of such blanket" or for "areas of reduced thickness," or that its "purpose" would have been recognized "in

<sup>1</sup> See also *In re Kozlak*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

the pertinent art of" Nagata et al., are "mere conclusory statements." As such, they are plainly insufficient to qualify as the requisite "articulated reasoning with some rational underpinning" for explaining why a skilled artisan would actually combine their teachings to arrive at the present invention. Accordingly, reconsideration is respectfully requested.

Moreover, although a requirement for establishing obviousness, that these references are "analogous art" is insufficient *per se* to establish a motivation to combine their teachings. *In re Kahn, supra* ("The motivation-suggestion-teaching test picks up where the analogous art test leaves off . . ."). Since the Office Action fails to state any motivation for combining the references, or for otherwise modifying the structure shown in Nagata et al. to arrive at the claimed invention, a *prima facie* case of obviousness is lacking. Therefore, reconsideration is respectfully requested for this additional reason.

In summary, all the pending claims patentably distinguish over the prior art. Upon careful review and reconsideration of these issues in view of the preceding comments, it is believed the Examiner will agree with this proposition. Accordingly, the early issuance of a formal Notice of Allowance is earnestly solicited. If any fees are required, the Examiner is authorized to debit Deposit Account No. 50-0568.

Respectfully submitted,

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